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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/813,852    03/07/97    DOCKERY

R    21651.3

EXAMINER

PM82/0315

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ART UNIT

PAPER NUMBER

*27*

2167  
DATE MAILED:

03/15/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/813852

Applicant(s)

R.L. DOCKERY et al

Examiner

F.J. BARTUSKI

Group Art Unit

2167

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on Feb. 12, 2001
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1, 4, 10 AND 17-28 is/are pending in the application.
- Of the above claim(s) 1, 4, 10, 17 AND 26-28 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 18-25 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election without traverse of Group II, claims 18-25 in Paper No. 27 is acknowledged.
2. Claims 1, 4, 10, 17 and 26-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 27.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 18 and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the February 1996 Consumer Reports magazine. The February 1996 Consumer Reports magazine includes a plurality of articles as shown in the

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table of contents, the article on receivers on pages 28 and 29 identifies products by brand name, includes information pertaining to the products and promotes purchase of some of the products by making best buy recommendations.

5. Claim 18 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bullard, Jr. Bullard, Jr. shows a magazine, booklet, book, catalog or pamphlet, see col. 2, lines 30-33, that includes a plurality of articles promoting the purchase of a plurality of products, each article includes information pertaining to one of the products, see col. 2, lines 51-65.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

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and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bullard, Jr. in view of Lamphere et al. Bullard, Jr. shows a magazine with all the features of the applicants' claimed invention except for the magazine being specific to a particular store. Lamphere et al show a promotional booklet that is specific to a particular store, see col. 10, lines 51-61. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Lamphere et al to make the magazine of Bullard, Jr. specific to a particular store to aid shoppers in finding the advertized products.

8. Claims 18 and 20, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bullard, Jr. in view of Lamphere et al. Bullard, Jr. shows a magazine with all the features of the applicants' claimed invention except for disclosure of who commissioned the articles. It would have been obvious to one of ordinary skill in the art in view of the disclosure in col. 9, lines 5-12 of Lamphere et al to sell advertising space in Bullard, Jr. to store brands or national brands.

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9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bullard, Jr. in view of Lamphere et al as applied to claim 21 above. Further, it would have been obvious to one of ordinary skill in the art in view of the store name on the cover of the booklet in Fig. 4 of Lamphere et al to place the store name on the cover of the magazine of Bullard, Jr. so the shopper takes the right magazine to each store.

10. Claims 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bullard, Jr. in view of Shedd. Bullard, Jr. shows a magazine with all the features of the applicants' claimed invention except the coupons. It would have been obvious to one of ordinary skill in the art in view of the coupons 3 in the promotional book of Shedd to provide the magazine of Bullard, Jr. with coupons to encourage sales.

*Conclusion*

11. Hirasawa and Figueres are cited to show other magazines with promotional material.

12. Any inquiry concerning this communication should be directed to F. J. Bartuska at telephone number (703) 308-1111.

  
F. J. BARTUSKA  
PRIMARY EXAMINER 3/12/01